

REMARKS

Claims 2-14 and 22-26 are currently pending in the application. Claims 15-21 and 26 have been cancelled herein without prejudice. Claims 2-14 and 22-26 are presently before the Examiner.

Submitted herewith is evidence in support of patentability in the form of a Declaration under 37 C.F.R. § 1.132 of Donald Hayden (hereinafter, “the Hayden Declaration”). Applicants respectfully request reconsideration of the subject patent application in light of the below remarks and evidence submitted herewith.

Claim Rejections under 35 U.S.C. § 102

Claim 27 was rejected as allegedly being anticipated by U.S. 2002/0147745 to Houben. Applicants have cancelled Claim 27 without prejudice to narrow the present issues before the Examiner, but do not acquiesce in the position set forth in the Office Action. Applicants reserve their right to pursue Claim 27 in a continuation or divisional application.

Claim Rejections under 35 U.S.C. § 103

Claims 2-14 and 22-26 were rejected as allegedly being obvious over U.S. Patent No. 5,991,751 (“Rivette”) alone, or in combination with U.S. Patent No. 6,556,992 (“Barney”) and/or Houben. Applicants respectfully traverse the rejections.

Applicants thank the Examiner for withdrawal of the rejection under 35 U.S.C. § 102. The pending claims have been rejected as being obvious over references that, in essence, teach patent search engines. There is simply nothing in a patent search engine that would lead one to develop a product embraced by the pending claims, such as the West km product sold by Thomson Reuters. A user manual for West km is annexed to the specification of this application.

The particular context of the pending claims, that being legal services and attorney work product, are especially important and are entitled to patentable weight. If these features were not critical, then the West km product, which is encompassed by the pending claims, would not have enjoyed any commercial success or solved a long-felt but unsolved need.

The Hayden Declaration, submitted herewith, summarizes the key features of the West km product that have led to its widespread adoption in the legal industry over the past eight years. (Hayden Decl. at ¶¶1-10). The most critical features of this product that have led to its success are encapsulated by the pending independent claims. (Id. at ¶11).

Prior to the development of the West km product, law firms generally relied on document management systems, such as the PC DOCS or IManage systems, to control their documents and make work product available firm-wide. A goal of these systems was to help law firms with knowledge management. For example, these kinds of systems in theory would permit anyone at a law firm to go into the system and look, for example, for a memorandum on a topic of law. However, these document management systems have done little more than make it easier for a user to find documents that they have worked on in the past. Their ability to permit a user to cross-leverage the work product of other people is severely limited. (Id. at ¶¶ 4, 6). Some have attempted to tackle the problem solved by the West km product and failed. (Id. at ¶4).

The West km product is designed to help a law firm or legal department leverage its accumulated knowledge that is stored in the form of electronic memoranda and briefs. Put another way, this product is designed to help law firms and similar organizations with “knowledge management.” (Id. at ¶2). Customer demand for the West km product is rooted in its technical features and search capabilities, which permit law firms to leverage internal knowledge and work product like never before. (Id. at ¶¶ 4-9). While some of the most

significant features are claimed in the independent claims, (Id. at ¶11), it will be appreciated that the sub features set forth in the dependent claims are also important and called out in the Hayden Declaration and Exhibits appended thereto.

In short, it is respectfully submitted that embodiments of the claimed invention have solved a long-felt need in the art and enjoy commercial success because they do so. It is further submitted that a strong nexus exists between the pending claims and the basis for customer demand, demonstrating that the claim scope presently sought is commensurate in scope with the evidence of record. If the claimed invention were obvious and the problems it solves were easy to solve, it would have been done long ago by someone else, but it was not.

These problems were certainly not solved by the references of record, which are generally directed to patent search engines. There is simply nothing in a patent search engine that would lead one to develop a product such as West km. (Id. at ¶10). West km and the references of record are in two unrelated fields of endeavor. (Id.). This is because law firm documents, which typically include work product documents such as memos and briefs, are fundamentally different from patent documents. Work product documents include citations to legal authority, which are most typically citations to published legal decisions and statutes. (Id.). Whether the content of a brief or memorandum is still useful or not to a practitioner will depend almost entirely on whether the legal authority cited therein has been overturned or modified. The West km engine takes those legal memoranda and briefs, and updates them automatically so a user can determine, essentially in real time, whether a memorandum includes good authority, or whether the authority needs to be updated. (Id.). This is an invaluable feature of West km, and it is claimed in the pending claims of this patent application and is lauded by users of the product. (E.g., Hayden Decl., Exh. 6). Patents, on the other hand, sometimes cite other patents, but these

documents are not considered to be internal legal work product. They are merely publicly available documents. Users do not do searches for patents to determine whether they cite current legal authority. Put another way, patent search engines are concerned with different goals and objectives than West km. It is respectfully submitted that using a patent search engine reference to reject the instant application does not set forth a proper prima facie case of obviousness, particularly since such a reference has no teaching as to how to build an engine that sorts through and updates law firm internal work product documents. Filling in the large technical gaps between the references of record and claimed invention can only be accomplished by hindsight reconstruction, which is not permissible.

Formal Request For Interview

Applicants respectfully request an interview with the Examiner to discuss the present application and the prior art of record if the Examiner disputes the patentability of the pending claims. A demonstration of the West km system will gladly be arranged. Applicants' attorney of record Brian Pollack may be reached at (203) 353-6876 to schedule a mutually convenient date and time and to provide assistance or additional information if required.

CONCLUSION

Applicants respectfully request allowance of this application. The Director is hereby authorized to charge any fee deficiency associated with this paper (or with any paper filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 85192(307534).

Respectfully submitted,

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